

REMARKS

Claims 1 through 6 are pending in this application. Applicant acknowledges, with appreciation, the Examiner's allowance of claims 2, 3, and 6. Accordingly, the only remaining issue pivots about the patentability of claims 1, 4, and 5.

Claims 1 and 5 have been amended. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support for the present amendment should be apparent throughout the originally filed disclosure. Applicant submits that the present amendment does not generate any new matter issue.

Claims 1, 4 and 5 were rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Jones et al.

In the statement of the rejection the Examiner referred to Figs. 2 through 5 and to various portions of the patent text asserting the disclosure of an optical communication system and method corresponding to those claimed. This rejection is traversed.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.* 329 F.3d 1358 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). There is a significant difference between the claimed optical communication system and method on the one hand and the disclosure of Jones et al. on the other hand that scotch the factual determination that Jones et al. disclose an optical communication system and method identically corresponding to those claimed.

Specifically, independent claims 1 and 5 have been clarified by requiring selection of a channel whose signals are added to the optical transmission line, without generating any additional chromatic dispersion before adding the signals to the optical transmission line. That concept is neither disclosed nor suggested by Jones et al.

Indeed, Jones et al. disclose dispersion generating means 30 or 34, 36, provided between the branching unit 18 and the transmitter 24. It should be apparent that the dispersion generating means intentionally generates a chromatic dispersion in the optical path from the transmitter 24 to the branching unit 18 before the signals reach the branching unit 18 from the transmitter 24. This is in sharp contrast to the claimed invention which provides an elegantly simplified system and method involving the selection of a channel whose signals are added to the optical transmission line without generating any additional chromatic dispersion before adding the signals to the transmission line. In other words, each node includes a transmitter outputting signal of a signal channel aligned to the node itself. In accordance with the present invention, there is no structure for generating an additional chromatic dispersion in an optical path from the transmitter to the optical transmission line, thereby reducing costs and simplifying the system and method. Applicant would stress that the claimed optical communication system (and method) are clearly different from the branching unit 18 of Jones et al. and provide an advantage not realized by Jones et al.

The above argued functionally significant differences between the claimed optical communication system and method and those disclosed by Jones et al. undermine the factual determination that Jones et al. disclose an optical communication system and method identically corresponding to those claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicant, therefore, submits that the

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imposed rejection of claims 1, 4 and 5 under 35 U.S.C. § 102 for lack of novelty as evidenced by Jones et al. is not factually viable and, hence, solicits withdrawal thereof.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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